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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 10/822,182  | 04/09/2004  | Robert N. Hamlin     | 10527-003008                  | 1770             |
| 26161   | 7590        | 07/13/2006           | EXAMINER                      |                  |
| FISH & RICHARDSON PC<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | WOLLSCHLAGER, JEFFREY MICHAEL |                  |
|   |             |                      | ART UNIT                      | PAPER NUMBER     |
|   |             |                      | 1732                          |                  |

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/822,182

Applicant(s)

HAMLIN, ROBERT N.

Examiner

Jeff Wollschlager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 080904; 071204
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-30, 32, and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the instant specification, applicant discloses that a tensile layer (including a liquid crystal polymer) is combined as an outer layer with a chemically and physically compatible adhesion or bonding inner layer (page 2,, last paragraph – page 3, line 36). Therefore, the instant specification does not clearly support a layer of a liquid crystal polymer located as an inner tensile layer, or a different polymeric material as the outer layer, as would be supported by the present claims. The liquid crystal polymer layer should be claimed as the outer layer, or external to the inner layer, and the second layer recited as the inner layer, as supported by the present specification.

Further, the recitation, “a second layer comprising a second polymeric material different from the first polymeric material” recites limitations broader than the disclosed invention will support. The instant specification specifically discloses that the inner layer is a physically compatible adhesion or bonding layer. Therefore, providing a polymeric

material layer different than the first polymeric material may not provide the function of an adhesion or bonding layer as supported by the present disclosure. The claims are recited more broadly than the present specification will support.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 26-34 of copending Application No. 10/839,687 in view of Kingsford (U.S. Patent 4,799,717; issued January 24, 1989). The instant claims and the claims found in application 10/839,687 are directed to similar method steps. The differences between the applications are the polymeric materials employed as the first layer in producing a laminated expander member. In the instant application, the first layer comprises a liquid

crystal polymer. In application 10/839,687, the first layer comprises polyetheretherketone or polyetherketone. These polymers are known to be interchangeable in applications requiring high strength and temperature capabilities as evidenced by Kingsford (col. 5, lines 23-29).

This is a provisional obviousness-type double patenting rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Harvey et al. (U.S. Patent 5,589,236; issued December 31, 1996; priority date June 16, 1989).

Regarding claim 26, Harvey et al. teach a method of producing a laminated expander member/tube comprising: coextruding different polymeric materials to form a multilayer parison comprising a first layer comprising a first polymeric material including a liquid crystal polymer a second layer comprising a second polymeric material different from the first polymeric material and forming the parison into the expander member/tube (col. 1, lines 18-24 and 58-67; col. 4, lines 15-20; col. 12, lines 38-43).

As to claim 27, Harvey et al. teach coextruding a third layer disposed towards and exterior of the expander member relative to the first and second layers. In certain embodiments, the third layer employed by Harvey et al. inherently enhances the lubricity of the expander member/tube (col. 13, line 30- col. 14, line 11).

As to claims 28 and 33, Harvey et al. teach biaxially orienting the first layer, drawing the parison and expanding the parison in a blow molding operation (col. 14, lines 5-11; col. 11, lines 50-52; col. 3, lines 2-15; col. 4, lines 52-58).

As to claim 29, Harvey et al. teach the first layer consists essentially of a liquid crystal polymer (col. 12, lines 25-47).

As to claims 30 and 31, Harvey et al. teach the second layer is an adhesion/tie layer that is disposed toward the interior of the expander member/tube relative to the first layer (col. 4, lines 38-44; col. 12, lines 25-36).

As to claim 32, Harvey et al. does not expressly state that the expander member/tube has a radial expansion not exceeding three percent when inflated to seven atmospheres. However, Harvey et al. employs the same steps and materials as claimed in the instant application. Therefore, this physical property would inherently exist in the product made by Harvey et al.

### ***Conclusion***

All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Wollschlager whose telephone number is 571-272-

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8937. The examiner can normally be reached on Monday - Thursday 7:00 - 4:45, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JW

Jeff Wollschlager  
Examiner  
Art Unit 1732

July 7, 2006

cf  
CHRISTINA JOHNSON  
PRIMARY EXAMINER  
7/7/06